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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,076	03/18/2000	Geoffrey B. Rhoads	60131	5497
23735	7590	12/14/2005	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			ZIA, SYED	
			ART UNIT	PAPER NUMBER
			2131	
DATE MAILED: 12/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/531,076

Applicant(s)

RHOADS ET AL.

Examiner

Syed Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/02/05</u>                                                              | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on September 6, 2005. Original application contained Claims 1-16. Applicant previously canceled Claims 6-16, and added new Claims 17-22. Applicant currently cancelled Claim 2, and added new Claims 23-31. Therefore, presently pending claims are 1, 3-5, and 17-31.

### ***Response to Arguments***

1. Applicant's arguments filed September 6, 2005 have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1, 3-5, and 17-31 applicant argued that "the step of connecting is done under the control of the intermediate node and not by a user at the user node or by the any action at the user node... user cannot prevent this from happening ... prevent such connection" This is not found persuasive. CPA (Cited Prior Art) [Hudetz et al., US Patent No. 5,978,773] clearly teaches a local computer that is provided with a bar code reader. This reader reads bar codes from products in a standard product code format. The bar code is input to an Internet browser on the computer. The computer accesses a service provider and forwards the bar code value to it. The server uses the bar code to access a database. From this is retrieved an Internet address and this is used to connect the computer to that site. The site may have information about the product, or be a site identified by the product to get information regarding the product

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by extracting, and assembling a message packet associating network routing information with the extracted product code information, thereby enabling the interfacing over the network (Fig.1-10, and col.8 line 24 to col.9 line 65). Therefore, in the system of cited prior art the intermediate node controls every connection, and the user cannot prevent this from happening, thus intermediate node guarantee the connection accordingly.

As a result, the system of cited prior art does implement a method for automatic response to the step extracting product code and associating this with network routing to assemble message packet for transmission by linking between objects and associated remote resources.

Therefore, the examiner asserts that system of cited prior art does teach or suggest the subject matter as recited in independent claims 1, 3, 17, 23-24, and 30. Dependent claims are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in the this office action. Accordingly, rejections for claims 1, 3-5, and 17-31 are respectfully maintained.

### ***Claim Rejections - 35 USC § 112***

Claims 28, and 31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term “a bound volume “ is not described.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3-5, and 17-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudetz et al. (US Patent 5,978,773).
2. Regarding Claim 1 Hudetz teaches and describes a method comprising:
  - sensing an object identifier [local host system 28 with barcode reader 44 reading the barcode 48] from a first object [UPC number] (col.8 line 24 to line 46);
  - sending said first object identifier from a first device to a second device [(Web server) resident on a local service provider] (col.8line 40 to line 46);
  - in response, at said second device, identifying address information corresponding to said first object identifier and sending same to the first device (col.8 line 40 to line 53, and col.7 line 65 col.8 line 2);
  - initiating a link from the first device in accordance with said address information [such as record 62, 64, 66, Fig.4], at said second device, identifying additional objects related to said

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first object but not having the same object identifier sent from the first device to the second device, identifying additional address information corresponding to said additional objects; and sending said additional address information to the first device (col.7 line 65 col.8 line 2, col. 8 line 47 to line 63, and col.9 line 5 to line 6);

- storing said additional address information in a memory at the first device (col.9 line 6 to line 11); wherein, if an object included among said identified additional objects is sensed by the first device, the corresponding address information can be retrieved from said memory in the first device without the intervening delays of communicating with the second device (col. 9 line 14 to line 21).

3. Regarding Claim 3 Hudetz teaches and describes system for linking from physical or digital objects to corresponding digital resources, comprising:

- registration means for receiving data relating [local host system 28 with barcode reader 44 reading the barcode 48] to an object [UPC number] (col.8 line 24 to line 46), including its identity and owner, and associating same in a database [item 60 Fig.1] with data relating to a corresponding response (col.8 line 40 to line 53, and col.7 line 65 col.8 line 2),

originating device [local host 28] means for sensing data from an input object [barcode reader44], processing same, and forwarding same to a routing means [item 20 fig.1] (col.8 line 24 to line 46);

routing means for processing the processed data from the originating device means, logging information from same, and forwarding at least certain of said processed data [such as

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record 62, 64, 66, Fig.4] to a product handler means (col.8 line 47 to line 63, and col.9 line 5 to line 6;

an product handler means for providing a response to the originating device (col.9 line 6 to line 11) means in accordance with the information provided thereto by the routing means (col. 9 line 14 to line 21).

4. Regarding Claim 17 Hudetz teaches and describes in a method of linking from physical objects to corresponding electronic resources, the method including decoding object payload data from a machine readable [local host system 28 with barcode reader 44 reading the barcode 48] feature associated with a physical object [such as from printed pages Fig.7 or [UPC number] (col.8 line 24 to line 46), querying a database [item 60 Fig.1] with at least some of said payload data to obtain address information associated with said physical object (col.8 line 40 to line 53, and col.7 line 65 col.8 line 2), and initiating an electronic link [item 20 fig.1] based on said obtained address information (col.8 line 24 to line 46), an improvement comprising foreseeing information about object payloads that may be forthcoming but that do not share the first object the payload data with which the database was queried, and anticipatory sending address information associated with such foreseen payloads data [such as record 62, 64, 66, Fig.4] (col. 8 line 47 to line 63, and col.9 line 5 to line 21).

5. Regarding Claim 23 Hudetz teaches and describes a method comprising:

- sensing an object identifier [local host system 28 with barcode reader 44 reading the barcode 48] from a first object [UPC number] (col.8 line 24 to line 46);

sending said first object identifier from a first device to a second device [(Web server) resident on a local service provider] (col.8 line 40 to line 46);

in response, at said second device, identifying address information corresponding to said first object identifier and sending same to the first device (col.8 line 40 to line 53, and col.7 line 65 col.8 line 2);

- initiating a link from the first device in accordance with said address information [such as record 62, 64, 66, Fig.4], at said second device, after initiating said link, identifying additional objects related to said first object; identifying additional address information corresponding to said additional objects; and sending said additional address information to the first device (col. 8 line 47 to line 63, and col.9 line 5 to line 6);

- storing said additional address information in a memory at the first device (col.9 line 6 to line 11); wherein, if an object included among said identified additional objects is sensed by the first device, the corresponding address information can be retrieved from said memory in the first device without the intervening delays of communicating with the second device (col. 9 line 14 to line 21).

6. Regarding Claim 24 Hudetz teaches and describes a method of linking from physical objects to corresponding electronic resources, the method including decoding object payload data local host system 28 with barcode reader 44 reading the barcode 48] from a machine readable feature associated with a physical object [UPC number] (col.8 line 24 to line 46), querying a database with at least some of said payload data to obtain address information associated with said physical object (col.8 line 40 to line 53, and col.7 line 65 col.8 line 2), and initiating an



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electronic link based on said obtained address information[such as record 62, 64, 66, Fig.4](col. 8 line 47 to line 63, and col.9 line 5 to line 6), an improvement comprising foreseeing information about object payloads that may be forthcoming, and anticipatorily sending address information associated with such foreseen object payloads after initiating said electronic link (col. 9 line 6 to line 65).

7. Regarding Claim 30 Hudetz teaches and describes a method of linking from physical objects to corresponding electronic resources, the method including decoding object payload data local host system 28 with barcode reader 44 reading the barcode 48] from a machine readable feature associated with a physical object [UPC number] (col.8 line 24 to line 46), querying a database with at least some of said payload data to obtain address information associated with said physical object (col.8 line 40 to line 53, and col.7 line 65 col.8 line 2), and initiating an electronic link based on said obtained address information[such as record 62, 64, 66, Fig.4](col. 8 line 47 to line 63, and col.9 line 5 to line 6), an improvement comprising foreseeing information about object payloads that may be forthcoming, and the order in which said other object payloads may be forthcoming, and anticipatorily sending address information associated with such foreseen object payloads, in such order (col. 9 line 6 to line 65).

8. Claims 4-5, 18, 19-22, 25-29, and 31 are rejected applied as above rejecting Claims 3, 17, 24, and 30. Furthermore, system of Hudetz teaches and describes a system and method wherein

- the routing means includes means for checking information in the database (col.8 line 47 to line 53);

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- the registration means includes means for generating an encapsulating file and means for distributing said file to predetermined parties [Remote nodes 24, and 26](col.5 line 48 col.6 line 6);

- the physical object [Barcode, UPC] is a member of a logical set [manufacturer product identification], and the method includes anticipatorily sending address information associated with other objects [manufacturer products] that are also member of said logical set (Fig.4, col.7 line 4 to line 42));

- the logical set comprises of advertisements found in particular magazine (col.11 line 9 to line 20);

- foreseeing an order in which other object payloads may be forthcoming, and anticipatorily sending address information for each object payloads in said order (col.9 line 5 to line 20);

- said order is based on an order of printed pages in a bound volume (Fig.7, and col.10 line 3 to line 11);

- determining an order in which to send address information associated with said foreseen object based on a contractual arrangement (col.7 line 17 to line 27).

- the physical object is a member of a logical set, and the method includes anticipatorily sending address information associated with other objects that are also members of said logical set (col. 9 line 6 to line 65).

- the logical set comprises a set of advertisements found in a particular magazine (col. 11 line 9 to line 20).

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- includes foreseeing an order in which other object payloads may be forthcoming, and anticipatorily sending address information for such object payloads in said order (col. 9 line 6 to line 65).

- said order is based on an order of printed pages in a bound volume (col. 11 line 9 to line 20).

- includes determining an order in which to send address information associated with said foreseen object payloads based on a contractual arrangement (col. 9 line 44 to line 65).

- said order is based on an order of printed pages in a bound volume (col. 11 line 9 to line 20).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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November 28, 2005